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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,131	01/31/2001	Michel Marcel Jose Decre	PHNL000078	5393

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BRIARCLIFF MANOR, NY 10510

EXAMINER
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JOLLEY, KIRSTEN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/773,131

Applicant(s)

DECRE, MICHEL MARCEL JOSE

Examiner

Kirsten C Jolley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 15-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed November 24, 2004 have been fully considered but they are not persuasive.

Applicant has amended claim 1 to include the limitation of prior claim 7 "wherein said extension body further comprises at least two parts," and argues that Nishida et al. do not disclose or suggest that ring 20 can be formed from multiple parts. Applicant further argues that there is no disclosure or suggestion within Konishi et al. (the secondary reference upon which claim 7 was rejected) that liquid receiving base is made out of two parts. The Examiner acknowledges that Nishida et al. does not teach that its ring 20 comprises at least two parts, however the secondary reference of Konishi et al. is applied for its teaching of an extension body/liquid receiving base comprising at least two parts. See Figure 17 and col. 9, lines 51-58 which illustrates and describes a pair of liquid receiving bases 32a and 32b in contact with the outer peripheral edge of the wafer. It would have been obvious to one having ordinary skill in the art to have used a two-part ring/extension body fitted around the substrate in the method of Nishida et al., upon seeing the apparatus of Konishi et al., with the expectation of having an easier means for removal of the substrate and easier means for cleaning the coated extension body surfaces since the parts are completely separable from the rest of the coating apparatus.

Applicant also argues that there is no suggestion or motivation within Nishida et al. for using a polygonal or regular polygonal shape for the outer periphery in place of ring 20. The Examiner maintains the position that it would have been obvious for one having ordinary skill in

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the art to have also used a non-circular/polygonal extension body, such as a square or hexagon or octagon, with the expectation of achieving similar and equivalent results since the shape of the outer periphery of the ring/extension body is not critical to the process and would not affect the product produced, as long as the inner diameter of the ring/extension body remains the same as the outer diameter of the substrate (as taught by Nishida et al. in col. 11, lines 26-28). The shape of the extension body would be a matter of design preference. Also, it is noted that the now secondary reference of Konishi et al. teaches using an extension body having a rectangular shape. It would have alternatively been obvious to one having ordinary skill in the art to have used a square-shaped extension body in the invention of Nishida et al., instead of a circular ring, upon seeing the teachings of Konishi et al. with the expectation of similar and equivalent results since the shape of the extension body does not affect the coating formed.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 18-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new limitation in claim 18 “wherein a number sides [sic] for the at least two sides used to form said polygonal shape is equal to half of the sides within said polygonal shape”

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appears to be new matter. The Examiner could not locate disclosure of this limitation in the specification. If Applicant is attempting to claim that the number of *parts* of the extension body is equal to half of the number of sides of the polygonal shape based on support in Figure 2C (which illustrates three extension body parts and a hexagonal shaped body), it is noted that the disclosure of a single example (Figure 2C) does not provide support for claiming *all* structures where the number of parts is equal to half of the number of sides of the polygonal shape. Claim 19 is similarly rejected because it depends from claim 18 and does not cure the deficiencies of claim 18.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 18, it is not clear what is meant by the limitation “wherein *a number sides* [sic] for the at least two sides used to form said polygonal shape is equal to half of the sides within said polygonal shape” [emphasis added]. How is it possible that the number of *sides* used to form said polygonal shape is equal to half of the *sides* of the polygonal shape? Claim 19 is similarly rejected because it depends from claim 18 and does not cure the deficiencies of claim 18.

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishida et al. (US 6,349,086) in view of Konishi et al. (US 6,012,858).

The Nishida et al. and Konishi et al. references are applied for the reasons discussed in the prior Office action, as well as for the reasons discussed above in section 1.

Nishida et al. discloses a method of manufacturing a circular optical storage disc comprising: providing a substrate with a first surface and a periphery; providing a coating on the first surface by applying a liquid, rotating the substrate, and solidifying the liquid; and wherein applying the liquid onto the surface the substrate is present in a separate extension body (ring 20); the extension body having substantially circumferential contact with the periphery of the substrate, and having a surface substantially flush with the first surface of the substrate, as illustrated in Figures 12-15 and described in col. 11, lines 25-48; and after substantial solidification of the liquid, the extension body and the substrate are separated. It is known that substantial solidification of the liquid occurs in Nishida et al.'s process because solidification by UV curing occurs while ring 20 is still present around the substrate. Similarly, Applicant's own substantial solidification step is performing by UV curing while the extension body is still present around the substrate.

Nishida et al. does not teach that its ring 20 comprises at least two parts, however the secondary reference of Konishi et al. is applied for its teaching of an extension body/liquid

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receiving base comprising at least two parts. See Figure 17 and col. 9, lines 51-58 which illustrates and describes a pair of liquid receiving bases 32a and 32b in contact with the outer peripheral edge of the wafer. It would have been obvious to one having ordinary skill in the art to have used a two-part ring/extension body fitted around the substrate in the method of Nishida et al., upon seeing the apparatus of Konishi et al., with the expectation of having an easier means for removal of the substrate and easier means for cleaning the coated extension body surfaces since the parts are completely separable from the rest of the coating apparatus.

The dependent claims are rejected for similar reasons as discussed in the prior Office action and above in section 1.

As to new claim 17, it is noted that the two extension body parts 32a and 32b of Konishi et al. are congruent. As to claims 18-19, it would have been obvious for one having ordinary skill in the art to have selected the number of sides of each extension body, or the number of total parts, as a matter of design preference since the shape of the fractions/partial pieces of the extension body do not materially affect the process or coated product.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

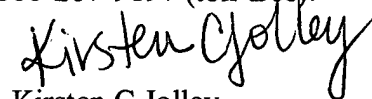
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kirsten C Jolley  
Primary Examiner  
Art Unit 1762

kcj